

REMARKS/DISCUSSION OF ISSUES

Applicant thanks the Examiner for acknowledging the claim for priority and for acceptance of the drawings.

Claim 13 is finally rejected under 35 USC 112, first paragraph, and the specification is objected to, in that the phrase 'an anodized layer which supports said outer layer' is not supported by the specification.

This phrase is not new matter since it has been present in claim 13 since the time of filing of the Application. Thus, Applicant is entitled to amend the specification to add the phrase originally present in claim 13.

Nevertheless, the Examiner objects to the addition of the following sentence:

'The metal or alloy may additionally support an anodized layer, in which case the anodized layer supports the outer layer 3.'

Accordingly, the present amendment adds the alternate sentence:

'The sole may further comprise an anodized layer, in which case the anodized layer supports the outer layer 3.'

This sentence is fully supported by original claims 11-13. Claim 11 originally called for 'An element with a carrier structure (2; 22; 42) which support an outer layer (3; 23; 43) as claimed in any one of the preceding claims.

The sole referred to in the added sentence is one embodiment of the element referred to in original claim 11. See, e.g., page 1 of the specification, lines 5 and 6.

Original claim 12 called for 'An element as claimed in claim 11, wherein the material of the carrier structure (2; 22;

42) is a hard material of permanent shape, such as a metal or a metal alloy, a ceramic material, a glass, or hard plastic.

Original claim 13 called for the element as claimed in claim 12 to **further** comprise an anodized layer which supports said outer layer.

Thus, claim 11 called in pertinent part for an element (e.g., sole) with a carrier structure which supports an outer layer, while claim 12 specified that the carrier structure may be a metal or a metal alloy, and claim 12 called for the element to further comprise an anodized layer which supports the outer layer.

There is no other interpretation for the above language than that the anodized layer is located between the carrier structure and the outer layer. Otherwise, the outer layer could not be supported by the anodized layer.

Claims 11 and 12 have been cancelled, but the critical language from these claims has been incorporated into claim 1, and claim 13 has been made dependent on claim 1.

Specifically, claim 1 now calls in pertinent part for an element comprising a carrier of a metal or metal alloy and an outer layer, while claim 13 calls for the carrier to further comprise an anodized layer **which supports said outer layer**.

Since Applicant is entitled to amend the specification with matter which was present in the claims as originally filed, and since the phrase 'an anodized layer which supports said outer layer' was present in claim 13 as originally filed, it is urged that the sentence added to the specification is not new matter, and claim 13 is fully supported thereby.

Accordingly, it is urged that the rejection under 35 USC 112, first paragraph, and the objection to the specification are in error and should be withdrawn.

Claims 1-3, 6, 9 and 10 are finally rejected under 35 USC 102(b) as being anticipated by Robertson.

In response to Applicant's previous arguments, the Examiner states that Robertson's silicone polymer has TiO₂, which is equivalent to a polymer material with an inorganic main chain, citing col. 6, lines 25-35. However, the phrase 'and which contains TiO₂ coated mica' in line 30 refers back to the term 'coating' in line 27, not to the term 'silicone resin' in line 28.

Thus, the sentence structure of paragraph (a) beginning at line 26 is as follows:

Line 27: a coating

Line 28: containing silicone resin

Line 30: and which contains TiO₂ coated mica

TiO₂ is not part of the structure of the polymer material, but is merely added to the polymer coating as an opacifying pigment. See col. 5, lines 34 et seq., where it is stated:

'The coatings of choice are silicone resin coatings.. Such coatings are pigmented conventionally with opacifying pigment (TiO₂ or Al₂O₃...)..'

Even if the passage quoted by the Examiner meant that the TiO₂ were a part of the polymer structure, it would be present as a pendant group, not as a part of the main chain.

The Examiner urges that Robertson teaches that the coating has a dense translucent form, citing col. 5, lines 60, 61, having pigmented fillers, citing col. 5, lines 50-52. However, what Robertson actually states is that the siloxane matrix is translucent (col. 5, line 61), but that opacifying pigment fillers are added (col. 5, line 52).

Thus, Robertson does not teach or suggest a laser-markable material with a dull-translucent surface. Moreover, in

specifically calling for the addition of an opacifying agent such as TiO₂, Robertson actually teaches away from Applicant's claimed invention.

In response, the Examiner has argued that since the polymer matrix is translucent, then the surface is also translucent. However, the matrix is only translucent prior to the addition of an opacifying agent, not afterward. After the addition of the opacifying agent, both the matrix and the surface are opaque, not translucent.

With regard to claim 13, Robertson does not teach or suggest an anodized layer supporting the outer layer.

Accordingly, it is urged that the rejection is in error, and should be withdrawn.

Claims 7 and 8 are objected to as being dependent on a rejected base claim. Accordingly, new claims 25 and 26 are presented, which combine the limitations of claims 1, 6 and 7, in the case of claim 25, and claims 1 and 8, in the case of claim 26.

Nevertheless, it is urged that claims 7 and 8 are allowable in their present form, by virtue of their dependency on claim 1, for the reasons advanced above.

In view of the foregoing, Applicant respectfully requests that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance.

Respectfully submitted,


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